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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/708,693

06/04/2004

Lloyd Ballard Mauldin

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7590

02/02/2005

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EXAMINER

BOYKIN, TERRESSA M

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/708,693

Applicant(s)

MAULDIN ET AL.

Examiner

Terressa M. Boykin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-24 is/are allowed.
- 6) ☒ Claim(s) 25-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Claim Rejections-35 USC 112 second paragraph**

Claims 40 and 41 are rejected under 35 USC 112 second paragraph as being indefinite for failing to particularly point out and distinctly claims the subject matter which applicants regards as the invention.

The claim "obtained by" is unclear and indefinite because it infers that the objective can be obtained by other means, i.e. other than admixing etc.....and thus fails to meet the requirement of the statute that a claim must particularly point out and distinctly claim what applicant regards as his invention. A suggested phrase may be "produced by" to avoid ambiguity.

**Claim Rejections 35 USC 112 first paragraph**

Claims 25-41 are rejected under 35 USC 112 first paragraph, because the specification, while being enabling for the broadly defined coating composition does not support the broadly defined claims as written.

Claims 25, 40 and 41 recite elements without support in the original disclosure under **35 U.S.C. 112**, first paragraph, *Waldemar Link, GmbH & Co. v. Osteonics Corp.* 32 F.3d 556, 559, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

The specification is directed specifically to separation of polyolefins from particular polyamide, i.e. Nylons. However, each of the claims 25, 40 and 41 are directed to the admixing of a commingled polymer composition comprising a polyolefin and polyamide

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in general.

It is noted that although the CCPA has criticized the use of the characterization "too broad" or undue breadth"... however, an application whose claims(s) are of a breadth which are not adequately supported by its specification is in violation of 35 USC 112 first paragraph. In re Borowski et al., (CCPA 1970) 424 F2d 904; In re Wakefield, (CCPA 1970 422 F2d 897; In re Hammack, (CCPA 197).

608.04(a) Matter not in the original specification, claims, or drawings is usually new matter. Depending on circumstances such as the adequacy of the original disclosure, the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter. See *Ex parte Vander Wal*, 109 USPQ 119, 1956 C.D. 11, 705 O.G. 5 (Bd. App. 1955) (physical properties), *Ex parte Fox*, 128 USPQ 157, 1960 C.D. 28, 761 O.G. 906 (Bd. App. 1957) (new formula) and *Ex parte Ayers*, 108 USPQ 444 (Bd. App. 1955) (new use). For rejection of claim involving new matter, see **MPEP § 706.03(o)**.

### **Correspondence**

Please note that the cited U.S. Patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)) from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center at [Http:www.uspto.gov/ebc/index.html](http://www.uspto.gov/ebc/index.html) or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday at 9:00am to 4:00pm.

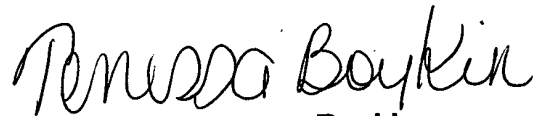
The fax phone number to the organization where this application or proceeding is assigned is 703 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private Pair or Public Pair. Status information for unpublished application is available through Private PAIR only. For more information

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about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1 866-217-9197 (toll-free)

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A handwritten signature in black ink, reading "Terressa Boykin". The signature is written in a cursive, flowing style.

**Examiner Terressa Boykin**  
**Primary Examiner**  
**Art unit 1711**